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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,889	09/23/2006	Seiji Kashioka		5759

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EXAMINER	
MILLIKIN, ANDREW R	
ART UNIT	PAPER NUMBER
2837	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/593,889	KASHIOKA, SEIJI	
	Examiner	Art Unit	
	Andrew R. Millikin	2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. The previous restriction requirement is withdrawn in view of the claim amendments submitted 8 July 2008.

Specification

2. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: “takt timing,” “takt duration data,” “week takts,” “a player of provided media of sound recording with making synchronization of two,” “meat the timing,” etc. It is noted that these are only examples, and are not the only revisions that need to be made.

3. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Objections

4. Claim 5 is objected to because of the following informalities: reference is made to "collection purpose" and "takt," which were elsewhere amended to "modification purpose" and "beat." Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim is directed to nonfunctional descriptive material per se (media holding data).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention. The concept of "making duration data of each beat aligned with the recording of the first step" does not appear to have been described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 6: It is unclear what is meant by "recording of full member performance," "sound recording of performance missing specific part," and specifically it is unclear what meant by "specific part."

12. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

13. Claims will be treated as best understood in their present form.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Herberger et al. (U.S. Patent No. 6,518,492, hereafter '492).

16. Claim 4: '492 teaches a computer readable memory containing computer program to indicate consecutive beat timing (see claim 3), said program comprising: first program for reading out data about each beat duration time stored in memory or media and get beat duration time one by one (cols. 5-6); second program for measuring period of said duration time one by one (col. 6); third program for indicating the timing of passing of said measured period by visual, audio or other output (see claim 3).

17. Claim 5: '492 teaches a computer readable memory containing computer program claimed in claim 4, the program further comprising: fourth program for input of the beat timing from a mouse or other device operated by user for initial input or partial modification purpose (col. 11, lines 53-65); fifth program for recording beat duration data on memory or media based on input by fourth program (col. 12).

18. Claim 8: '492 teaches media holding beat duration data about music, performance or operation to be used on the apparatus claimed in claim 1.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20. Claims 1-3,and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over ‘492 in view of Tumblin (U.S. Patent No. 4,321,853, hereafter ‘853).

21. Claim 1: ‘492 teaches an apparatus which indicates consecutive timing of beat (see claim 3), comprising: first means for reading out data about each beat duration time stored in memory or media (cols. 5-6); second means for measuring period of said duration time one by one (col. 6); third means for indicating the timing of passing of said measured period using visual, audio, or other output (see claim 3).

22. ‘492 does not explicitly state that the apparatus is a metronome apparatus, though it could be construed as such, since it displays the BPM of a track. However, '853 teaches that metronomes are useful in order to show timing (col. 2, line 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a metronome like that of ‘853 with '492 in order to have indicated the timing of passing of said measured periods using a metronome since they are known to be useful in showing timing. This could be used to assist in “many settings” such as when combining “musical elements that have been taken from different compositions” or in a “DJ setting,” as are described in ‘492 in the paragraphs bridging cols. 1 & 2. Further, a metronome could be used with '492 in order to allow a performer to play along with a song which has been analyzed for beats using the method of ‘492.

23. Claim 2: '492 & '853 teach the metronome apparatus claimed in claim 1, further comprising: fourth means for input of the beat timing with a button or other device operated by user for initial input or partial modification purpose ('492, col. 11, lines 53-65); fifth means for recording data acquired by fourth means on memory or media ('492, col. 12).

24. Claim 3: '492 & '853 teach the metronome apparatus claimed in claim 1, wherein the third means is a display for showing point of attention, which moves up and down, wherein downward movement changes to upward movement at the timing of beat ('853, col. 3, lines 8-37).

25. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over '492 & '853, as applied to claims 1 & 4 above, and further in view of Miyake (U.S. Patent No. 5,256,832, hereafter '832) and Kikumoto et al. (U.S. Patent No. 4,694,724, hereafter '724). '492 & '853 teach the metronome in claim 1 and the computer program stored in memory in claim 4 (see rejections above), but do not explicitly teach a method of production of music minus one or karaoke utilizing those metronomes/computer programs comprising: first step for sound recording of full member performance; second step for making duration data of each beat aligned with recording of the first step; third step for sound recording of performance missing specific part, wherein the performance is played in the same tempo with the performance of the first step, by means of providing the duration data of each beat made in the second step to the metronome in claim 1 or the computer program stored in memory in claim 4, and letting it tick the beat;

fourth step for writing the recorded sound made in the third step on the media such as compact disk or producing copies of it.

26. However, karaoke or "music minus one" tracks are commonly known in the art to be comprised of full performances with one part removed such that performers can perform the removed part along with the karaoke track. Since '492 and '853, as combined, teach a suitable method for detecting the beats of a track and displaying it using a metronome, and since metronomes have long been known to be useful in assisting performers to play with proper timing, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used, or at least to have tried using, this method to generate a metronome display in order to allow performers to play to the beat of the full performance. In creating a karaoke track (which are commonly known and would be obvious to create because they have long been known in the art to be useful in allowing users to play along with music), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized said generated metronome display in the recording of said karaoke track in order to assist performers in playing with the proper timing and to have recorded the sound made on a media such as a compact disk or producing copies of it in order to distribute the karaoke track to consumers.

27. Nonetheless, neither '492 nor '853 specifically teach a second step for making duration data of each beat aligned with recording of the first step, nor do they teach providing the duration data of each beat made in the second step to the metronome in claim 1 or computer program stored in memory in claim 4, and letting it tick the beat.

However, ‘832 teaches a method for making duration data of each beat aligned with a recording (see second embodiment spanning cols. 11 & 12), as does '724 (see paragraph spanning cols. 3 & 4; the user simply inputs the tempo themselves). As is noted in ‘832, a beat which is human and rich in music and not fixed as in a [normal] metronome is preferable (col. 15, lines 5-7) and “in actual performance, usually, [a song’s] tempo varies during the performance due to the performer's feeling or degree of elation" in which case "the beat count speed varies.” It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the methods described in ‘832 or ‘724 with ‘492 & ‘853 in order to align the duration data of each beat with the recording of the first step in order to have provided duration data of each beat in the second step to the metronome in claim 1 or computer program stored in memory in claim 4 in order to have accounted for the fact that in actual performance, usually, a song’s tempo varies during the performance due to the performer’s feeling or degree of elation.

28. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over ‘492, ‘853, ‘832, & ‘724, as applied to claim 6 above, and further in view of Endoh et al. (U.S. Patent No. 6,016,295, hereafter ‘295). '492, '853, '832, & '724, as combined above, teach the method claimed in claim 6, but do not explicitly teach that the media in the fourth step is delivered in such a way that duration data of each beat of the second step is combined with recorded sound of the third step on the same media including but not limited to compact disk or on individual media. However, ‘294 teaches that recording a

practice rhythm count or metronome sound on a karaoke track can be advantageous in order to help users to keep proper timing with the track (col. 10, lines 56-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a practice rhythm count or metronome sound on the karaoke tracks generated and recorded in claim 6 in order to help users keep proper timing with the track.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew R. Millikin whose telephone number is (571)270-1265. The examiner can normally be reached on M-R 7:30-5 and 7:30-4 Alternating Fridays (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Benson can be reached on 571-272-2227. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew R. Millikin/
Examiner, Art Unit 2837

/Walter Benson/
Supervisory Patent Examiner, Art Unit 2837